



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,459	04/24/2000	Mark Vincent Shoen	57111-5072	7663
24574	7590	09/07/2004	EXAMINER	
JEFFER, MANGELS, BUTLER & MARMARO, LLP 1900 AVENUE OF THE STARS, 7TH FLOOR LOS ANGELES, CA 90067			YEAGLEY, DANIEL S	
			ART UNIT	PAPER NUMBER

3611

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/557,459
Filing Date: April 24, 2000
Appellant(s): SHOEN, MARK VINCENT

MAILED

SEP 07 2004

GROUP 3600

Rod S. Berman
For Appellant

EXAMINER'S ANSWER

Art Unit: 3611

This is in response to the appeal brief filed 5/28/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

Art Unit: 3611

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1 - 3, 6 - 7, 9 - 13, 15 - 17, 19 - 20, 23 - 24 and 27-39 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

2,001,705	Caponi	6-1932
1,440,516	Whitton	5-1922
4,027,808	Hardwick	6-1977
4,422,664	Poveromo	12-1983
4,395,749	Poveromo	7-1983

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 34 – 38 stand rejected under 35 U.S.C. 102(b) and Claims 1 - 3, 6, 7, 9 - 13, 15 - 17, 19, 20, 23, 24 and 29 - 39 stand rejected under 35 USC 103(a). These rejections were set forth in the prior Office Action, mailed on February 03, 2003 as follows.

Claims 34 - 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitton '516.

Art Unit: 3611

Whitton show a fender (3 and 6) comprising a uniformed cross-section which is curved radially downward in a longitudinal direction as seen in figure 3, that includes a curved surface as shown in figure 4 in a lateral direction of the fender to an outer edge with an outer wall extending downward from the outer edge of the top portion, and a clearance increasing portion depending downward from an inner edge of the top portion at a non-zero acute angle in a plane with an inner wall (lower portion of numeral 6) depending downward from the increasing portion at a second non-zero acute angle in a second plane such that the top portion and the inner wall are oriented substantially perpendicular and the planes are non-coplanar and the angles are each between *about* 1 and 89 degrees, and wherein the clearance increasing portion is concaved as viewed from the interior surface of the increasing portion in a longitudinal direction of the fender as clearly shown in figure 1 and 3. Whitton further shows a light housing (element 10 and 5) which are connected (mounted) to the fenders and is clearly shown in figure 4 and are offset from a longitudinal midline of the fender as broadly claimed.

Claims 1 – 3, 6, 7, 9, 17, 29 - 31 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitton '516 in view of Caponi '705.

Whitton as restated above clearly shows a curved fender (figure 3) in conjunction with a wheel, wherein an outer wall depends downward from the outer edge of the top portion of the fender (figure 4) to cover at least part of the wheel (figure 2 and 3) with an increasing portion depending downward from the inner edge of the top portion of the fender (figure 4) with an inner wall (lower portion of numeral 6) extending downward from the increasing portion (left side of fender shown in figure 4) wherein, the angles of the fender are between 1 – 89 degrees at *about*

Art Unit: 3611

40 – 50 degrees that add up to *about* 90 degrees between the upper portion and the inner wall, and includes a light housing (5 and 10) which is mounted to the fender and offset from a longitudinal midline of the fender as broadly claimed but failed to show the light housing attached to the curved surface of the top portion.

Caponi clearly shows the art of applying a light housing to a top curved portion of a fender as claimed such that the light is attached to a top portion of the fender utilizing a light housing with a raised portion 14 adapted to receive a light fixture 34 that conforms to at least a portion of the curved surface which clearly teaches the prior art of attaching a light fixture to a curved portion of a fender in an offset position from a midline of the fender as clearly shown in figure 1 of Caponi.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the fender of Whitton and attached a light housing to the curved portion of the fender utilizing a light housing such as shown by Caponi that conforms to at least a portion of the curved surface as taught by the fender light apparatus of Caponi simply as an alternate mounting location for a head lamp or as an additional turn signal light apparatus for added safety to enhance the use of the vehicle which are well known in the vehicle art and obvious additions to one skilled in the art.

Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitton '516 as modified by Caponi '705 in further view of Hardwick '808.

Whitton '516 as modified by Caponi '705 failed to show a fender wherein the top portion comprises a plurality of planer sections with a substantially flat middle section and two curved

Art Unit: 3611

end sections. Hardwick shows a fender having a clearance increasing portion and inner and outer wall depending from the top portion of the fender which shows the prior art of constructing a fender such that the top portion comprises a substantially flat middle section and is curved downward at the end sections having a plurality of planer sections as shown in figure 1 of Hardwick.

It would have been obvious to one of ordinary skill in the art to have further modified the fender of Whitton as modified by Caponi with a fender such as shown by Hardwick having the top portion of the fender comprising a substantially flat middle section and curved downward at the end sections having a plurality of planer sections as clearly shown in figure 1 of Hardwick as a matter of design choice to cover the wheel or alternatively to cover an additional wheel of a vehicle, such as in the case of the fender as shown in the dual wheeled vehicle of Hardwick.

Claims 1 - 3, 6, 9 - 13, 15 - 17, 19, 20, 23, 24 and 27 - 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poveromo '664 in view of Poveromo '749.

Poveromo '664 shows in figure 1 a plurality of fenders 20,22 on a trailer or tow dolly, with a light housing 50 attached to a top of the fender in an offset manner from a midline of the fender as broadly claimed, the fender as shown in figure 3, and figure 7 show the top portion with a flat middle section and curved end sections at opposed inner and outer edges of the top portion with an outer wall extending downward from the outer edge of the top portion and a clearance increasing portion (angled portion) depending downward at a non-zero acute angle of about 1 - 89 degrees from the inner edge of the top portion to an inner wall that depends downward at a non-zero acute angle which is perpendicular to the top portion at approximately

Art Unit: 3611

90 degrees, figure 5 shows an alternate embodiment of a fender with a plurality of planer sections which is curved in the longitudinal direction and figure 8 appears to show all the bottom edges of the curved fender at their longitudinal ends of the top portion, inner and outer walls and clearance increasing portion all lying in a common plane as claimed wherein the light housing is attached to the curved portion of the fender by an integral base.

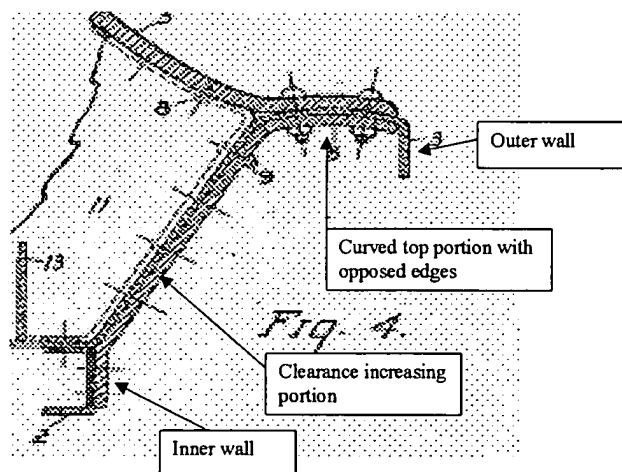
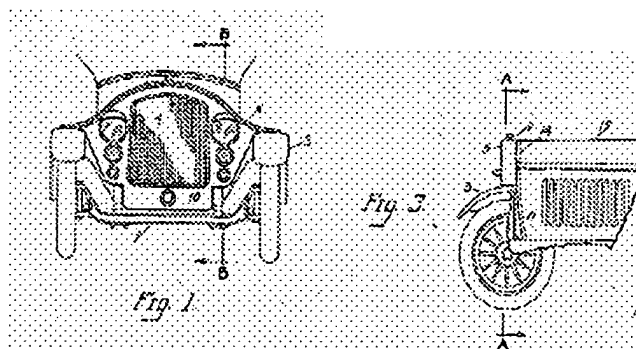
Poveromo '749 shows in figure 1 a plurality of fenders on a trailer or tow dolly with a light housing attached to a top portion of the fender, figure 7 shows the top portion with a flat middle section and curved end sections which is curved in the longitudinal direction, wherein figure 4 more clearly shows the light housing (figure 5) with a base portion 86 that conforms to at least a portion of the curved surface of the fender (figure 4) for attaching the light housing to the curved surface of a top portion of the fender as broadly claimed by applicant and wherein the raised portion 62 of Poveromo '664 are clearly capable of being attached to the base portion 86 of Poveromo '749 as modified.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of the Poveromo' fender mounted light housing arrangements and mounted the light housing in an offset manner such as shown by Poveromo '664 utilizing a more simpler base portion such as shown by Poveromo '749 which conforms to the curved portion of the fender as disclosed by the Poveromo references for mounting a light housing to the fender of a trailer to reduce manufacturing cost and add more clearance between the light housing in reference to the trailer bed as clearly depicted in figure 1 of Poveromo '664 as a matter of design choice dependent only upon users preference and the vehicles intended use.

Art Unit: 3611

(11) Response to Argument

1.) Whitton '516 shows a fender as broadly claimed (as clearly shown figure 4, components 3 and 6) which comprise a top portion that has a continuous curved upper surface with opposed inner and outer edges having a clearance increasing portion that depends downward from the inner edge at a non-zero acute angle in a first plane and includes an inner wall that depends downward from the clearance increasing portion at a non-zero acute angle in a second plane that is non-coplanar to the first plane and that is substantially perpendicular to the top portion and wherein as clearly viewed from figure 1 and 3 which shows the curved inner surface of the clearance increasing portion of the fender being obviously concaved in a direction from the front of the fender toward the rear of the fender as emphatically shown below.



2.) Whitton '516 shows a fender that includes a clearance increasing portion and downward extending inner wall as stated above and wherein the fender of Whitton further shows a light housing (elements 5 and 10, figure 1 and 4) which is offset from a midline of the fender and attached via element numeral 5 to the curved surface of the top portion of the fender as broadly claimed, but failed to show the light housing directly attached to the curved surface of the top portion; more like that of the applicants fender, and attached in a direction away from the clearance increasing portion. However, the Caponi reference clearly shows a fender having clearance increasing portions (side walls of fender with curved lower portions) which clearly shows the prior art of attaching a light housing directly to the curved top portion of a fender which is further shown being attached offset from the midline of the fender in a direction away from the inner-side increasing portion of the fender as broadly claimed.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, figure 1 and columns 1 through 2 of Caponi clearly suggests and recites motivational reasons for incorporating a light to the fender for safety and functional purposes which is further well known in the art to attach a light to a fender and would have been obvious to one of ordinary skill in the art. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor

Art Unit: 3611

is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

3.) Poveromo '664 shows various fender and light housing arrangements on a trailer or tow dolly for towing a boat (i.e.; vehicle), wherein a light housing which includes numeral 50 attached at a top surface of a clearly concaved curved fender (figure 4 and 8), figure 3 additionally clearly shows the somewhat curved portion of the fender having a uniform cross-section, wherein the light housing 50 is in an offset position from a midline of the fender as broadly claimed and further shows the top portion of the fender with a flat middle section and curved end sections at opposed inner and outer edges of the top portion of the fender with a clearance increasing portion (angled portion of fender shown in figure 3), wherein the clearance increasing portion is clearly shown having an inner concaved surface (side walls of the fender as seen in figure 4 and 8), the clearance increasing portion depends downward at a non-zero acute angle from the inner edge of the top portion to an inner wall that depends downward at a non-zero acute angle in a second plane which is perpendicular to the top portion (figure 3) and wherein figure 4 and 8; distinctively shows the bottom edges of the curved fender top portion, clearance increasing portion and inner and outer wall of the fender at their longitudinal ends of the fender lying in a common plane such as claimed. But, although the light housing of Poveromo '664 is attached to the somewhat curved portion of the fender via an integral base which is still considered broadly readable as being attached to the curved upper surface, Poveromo '749 however is cited as clearly showing the art of attaching a light housing which includes the base 82 being directly attached to the curved top portion of the fender as clearly

Art Unit: 3611

shown in figures 4 and 7 as more closely resembling the fender and light housing as broadly claimed.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Poveromo '749 recites a modification wherein the simply separate light housing structure could be made integral (column 3) and wherein the simply structure can be inexpensive to produce and easily installed on the upper portion of the fender and would have been obvious to one of ordinary skill in the art to have utilized a separate and more simpler light housing base portion such as suggested by Poveromo '749 which conforms to the curved portion of the fender for mounting a light housing to the fender of a trailer which would reduce manufacturing cost. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account

Art Unit: 3611

only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4.) Whitton '516 shows a fender that includes a concaved clearance increasing portion and downward extending inner wall as stated above and as modified by Caponi '705 having a light housing mounted to the top portion of the fender offset from the midline of the fender as broadly claimed. Wherein Hardwick discloses a fender which shows the prior art of constructing a fender having a substantially flat middle section and curved downward at the end sections having a plurality of planer sections (figure 1) and would have been obvious to one of ordinary skill in the art to have further modified the fender of Whitton as modified by Caponi with a fender such as shown by Hardwick as a matter of design choice to cover the wheel or alternatively to cover a plurality of wheels as suggested by Hardwick.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, such when covering a dual axle wheeled vehicle as taught by Hardwick.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

Art Unit: 3611

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

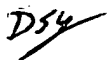
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



LESLEY D. MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Examiner - Daniel Yeagley
August 26, 2004



Conferees

Primary Examiner - Daniel DePumpo
SPE



- Lesley Morris



JEFFER MANGELS BUTLER & MARMARO LLP
TENTH FLOOR
2121 AVENUE OF THE STARS
LOS ANGELES, CA 90067